REMARKS

Claims 1-6, 11,17,32-37 and 42-56 are pending in the application. In the restriction requirement the Examiner has stated that the application contains Groups I and II:

Group I: claims 1-6, 11, 17, 32-37, 42-54, drawn to a pharmaceutical composition comprising at least one GABA analog and at least one NMDA antagonist;

Group II: claims 55-56, drawn to a method of treating CNS disorders by administering a pharmaceutical composition comprising at least one GABA analog and at least one NMDA antagonist.

Applicants herewith elect Claims of Group I, namely, Claims 1-6, 11, 17, 32-37, 42-54, drawn to a pharmaceutical composition comprising at least one GABA analog and at least one NMDA antagonist, with traverse. For the reasons stated below the restriction requirement is respectfully traversed.

Applicants traverse the restriction requirement because, as a practical matter, there is simply no way to search the claims of group I -- *thoroughly* -- without searching the other.

The disclosure presents only a single invention. That invention may be described in several independent claims and from several perspectives, but that does not change the nature of the invention. Thus, all the claims have "a community of properties justifying their grouping which [is] not repugnant to principles of scientific classification," *In re Harnish*, 631 F.2d 716, 206 U.S.P.Q. 300, 305 (C.C.P.A. 1980).

More importantly, in general, an applicant has a "right to define what he regards as his invention as he chooses, so long as his definition is distinct," *ibid.* And, "[a]s a general proposition, an applicant has a right to have each claim

examined on the merits," *In re Weber, Soden and Boksay*, 580 F.2d 455, 198 U.S.P.Q. 328, 331 (C.C.P.A. 1978). That court and its successor have long recognized the advantages to the public interest in permitting applicants to claim all aspects of the invention so as to encourage the making of a more detailed disclosure of all aspects of the discovery.

> We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112, all aspects of what they regard as their inventions, regardless of the number of statutory classes involved.
> *In re Kuehl*, 177 U.S.P.Q. 250, 256 (C.C.P.A. 1973).

Since it is the case that the claims all relate to the same invention, as evidenced in part by the fact that the United States Patent Office classification system indicates that the subject matter of both groups of claims would be listed in the same Class and Subclass after complete examination and allowance, thus searching the subject matter of this classification with that of others is the only way to yield ALL references pertinent to the invention, and there is no undue burden for the examination purposes.

Moreover, since the groups are related by composition of matter (group1) and method of treatment using the composition of matter (group 2), the method claims cannot be practiced with a different product since claim 56 recites the exact same limitations on the composition as claim 1 and therefore claims 55- require that the product of Claim 1 be used. For this additional reason the Applicants believe that the restriction should be reconsidered and withdrawn.

It should not be lost in this process that requiring applicants to pay filing fees, prosecution costs, issue fees, and maintenance fees for several patents for one invention is an undue burden for applicants.

The Examiner is also directed to M.P.E.P. §803, wherein it states:

> If the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to independent or distinct inventions. M.P.E.P §803 (emphasis supplied).

Therefore, as the claims contained in the application relate to the same invention, namely, a pharmaceutical composition, and a method of treatment using the pharmaceutical composition, all of which must be considered when searching the claims of each of the Groups I-II.

In making the restriction requirement the Examiner has also stated that the application contains more than one species of the generic invention. In particular the Examiner has requested that the applicant elect a species of:

(a) GABA analog;
(b) NMDA antagonist;
(c) Extended or immediate release form; and
(d) presence or absence of an additional active agent.

In order to comply with the above requirements, Applicant hereby elects without prejudice, with traverse and for search purposes only:

(a) the GABA analog species elected is Gabapentin;
(b) the NMDA antagonist species elected is Dextromethorphan;
(c) in extended release form; and
(d) for the CNS disorder of Anxiety.

Should the restriction requirement be maintained, the Applicant reserves the right to rejoin any withdrawn claims upon allowance of the generic claim, which the Examiner has acknowledged in making the restriction requirement.

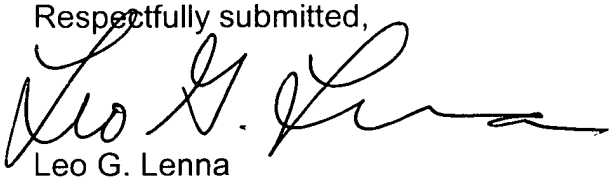
Should the Examiner believe that a telephone conference or personal

interview would facilitate resolution of any remaining matters, the Examiner may contact Applicant's attorney at the number given below.

Favorable action on the merits, and allowance of all claims, is respectfully solicited. Applicant reserve the right to file divisional applications to the subject matter of the unelected species in the event no generic claim is held allowable.

An early and favorable action is earnestly solicited.

Respectfully submitted,



Leo G. Lenna
Reg. No. 42,796
Attorney for Applicant

DILWORTH & BARRESE, LLP
333 Earle Ovington Blvd.
Uniondale, NY 11553
(516) 228-8484
(516) 228-8516 (FAX)